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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/236,552	01/26/1999	WATARU TOMIDA	102654	1322
25944	7590	05/25/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			POKRZYWA, JOSEPH R	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/236,552

Applicant(s)

TOMIDA, WATARU

Examiner

Joseph R. Pokrzywa

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16, 19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16, 19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>31</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 3/17/04, and has been entered and made of record. Currently, **claims 14-16, 19, 21, and 22** are pending.

Response to Arguments

2. Applicant's arguments, see pages 5 and 6, filed 3/17/04, with respect to the rejection(s) of independent claims 14 and 21 under 35 U.S.C. 103(a), previously cited as being unpatentable over Mori (U.S. Patent Number 6,384,927) in view of Cooper *et al.* (U.S. Patent Number 6,052,442), have been fully considered and are persuasive. The added limitation, which was previously found in now canceled claim 18, was cited as being taught by Mori. However, upon further consideration, the examiner concedes that Mori and Cooper each fail to teach of notifying a user when the image is formed based on determining if the electronic mail is high priority. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Maruyama *et al.* (U.S. Patent Number 6,430,272), with a discussion appearing below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 14-16, 19, 21 and 22** are rejected under 35 U.S.C. 102(e) as being anticipated by Maruyama *et al.* (U.S. Patent Number 6,430,272).

Regarding **claim 14**, Maruyama discloses an internet facsimile device (message switching apparatus 31) of a receiving party (see Fig. 8, column 15, line 61 through column 16, line 44) comprising means for receiving by the internet facsimile device via an internet at least one set of electronic mail data (column 16, lines 9 through 14) attached with an electronic mail title (being the "Subject" field), means for reading the electronic mail title (column 19, line 48 through column 20, line 11), means for displaying the electronic mail title that has been received along with the electronic mail data (see Fig. 26, column 16, lines 35 through 42, column 19, lines 8 through 63, and column 26, line 1 through column 27, line 44), means for selecting electronic mail data from the at least one set of electronic mail data based on the electronic mail title (column 19, line 8 through column 20, line 11, and column 27, lines 1 through 44), means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (column 19, line 8 through column 20, line 11), and means for forming an image based on electronic mail data selected by the data selecting means (column 19, line 8 through column 20, line 11), wherein the image forming means forms

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an image based on the electronic mail data which has been determined to have a high priority (column 19, line 8 through column 20, line 11), whereby the internet facsimile device prints the image formed by the image forming means automatically without any instructions from a user (column 19, line 8 through column 20, line 11, whereby an “urgent communication” is sent to a facsimile machine, thereby printing the image), and notifying means for notifying a user when the image forming means forms an image based on the electronic mail data which has been determined to have a high priority (column 19, line 8 through column 20, line 11, whereby an “urgent communication” is sent to a facsimile machine, thereby also notifying a user when the image is formed).

Regarding *claim 15*, Maruyama discloses the device discussed above in claim 14, and further teaches of a second receiving means for receiving facsimile data via a public network (telephone circuit network 16), and data converting means for converting the at least one set of the electronic mail data into facsimile data (column 10, line 60 through column 11, line 23, and column 15, line 65 through column 16, line 14), wherein the image forming means forms an image based on the facsimile data received via the public network and on the facsimile data converted from the at least one set of the electronic mail data (column 16, lines 10 through 42, and column 19, lines 8 through 47).

Regarding *claim 16*, Maruyama discloses the device discussed above in claim 14, and further teaches of means for determining whether or not each one of the at least one set of electronic mail data has a high priority based on a corresponding electronic mail title (column 18, line 57 through column 20, line 11), and means for notifying the user of electronic mail data having the high priority (column 19, line 8 through column 20, line 11).

Regarding *claim 19*, Maruyama discloses the device discussed above in claim 14, and further teaches that the priority determining means determines that a priority is high when corresponding electronic mail title contains a predetermined character (column 19, line 64 through column 20, line 11).

Regarding *claim 21*, Maruyama discloses a method of controlling an internet facsimile device (message switching apparatus 31) of a receiving party (see Fig. 8, column 15, line 61 through column 16, line 44) comprising the steps of receiving electronic mail data attached with a header by the internet facsimile device from a remote internet facsimile device (column 16, lines 9 through 14), the header including a title (being the “Subject” field), reading the title from the header (column 19, line 48 through column 20, line 11), displaying the title that has been received along with the electronic mail data (column 16, lines 35 through 42, and column 19, lines 8 through 63), determining whether or not the electronic mail has a high priority based on a corresponding electronic mail title (column 19, line 8 through column 20, line 11), and forming an image based on the electronic mail data which has been determined to have a high priority (column 19, line 8 through column 20, line 11), wherein the internet facsimile device prints the image formed based on the electronic mail which has been determined to have a high priority automatically without any instructions from a user (column 19, line 8 through column 20, line 11, whereby an “urgent communication” is sent to a facsimile machine, thereby printing the image), and notifying a user when the image is formed based on the electronic mail data which has been determined to have a high priority (column 19, line 8 through column 20, line 11, whereby an “urgent communication” is sent to a facsimile machine, thereby also notifying a user when the image is formed).

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Regarding **claim 22**, Maruyama discloses the method discussed above in claim 21, and further teaches of determining whether or not the electronic mail belongs to a predetermined group based on the title (column 18, line 57 through column 20, line 11), and notifying the user of an urgent mail when the electronic mail belongs to the predetermined group (column 19, line 8 through column 20, line 11).

Citation of Pertinent Prior Art

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Wicks *et al.* (U.S. Patent Number 5,796,394) discloses a system that processes electronic mail data based on stored rules.

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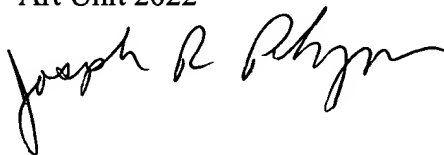
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Examiner
Art Unit 2622



jrp